

AP/3745

PATENT #
2008-0108P21
5/10/02
Dm

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Ernest J. CLAXTON, III et al.

Appeal No.:

Appl. No.: 09/034,313

Group: 3745

Filed: March 4, 1998

Examiner: VERDIER, C.

Conf.:

For: FIELD-SERVICEABLE SOLIDS HANDLING
VERTICAL TURBINE PUMPRECEIVED
MAY - 2 2002
TECHNOLOGY CENTER R3700SUPPLEMENTAL APPEAL BRIEF TRANSMITTAL FORMAssistant Commissioner for Patents
Washington, D.C. 20231:

April 26, 2002

Sir:

Transmitted herewith is a Supplemental Appeal Brief (in triplicate) on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. 1.8.

An Appeal Brief was filed on January 29, 2001.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27

☐ An extension of time under 37 C.F.R. § 1.136(b) to was requested on and was approved on

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

916
STALS

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

 #40,439

By Terrell C. Birch, #19,382

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

TCB:DRA/kdb
2008-0108P

(Rev. 01/22/01)

PATENT
2008-0108P



IN THE U.S. PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

In Re application of

Ernest J. CLAXTON, III et al.

Appeal No.: 2001-2527

Application No.: 09/034,313

Group: 3745

Filed: March 4, 1998

Examiner: C. Verdier

For: FIELD-SERVICEABLE SOLIDS-HANDLING
VERTICAL TURBINE PUMP

SUPPLEMENTAL APPEAL BRIEF
ON BEHALF OF APPELLANTS

RECEIVED

MAY - 2 2002

TECHNOLOGY CENTER R3700

Assistant Commissioner for Patents
Washington, DC 20231

April 26, 2002

Sir:

In response to the Order under 37 C.F.R. § 1.196(d) dated February 28, 2002, Appellants respectfully submit this Supplemental Appeal Brief to address the relevance of the case of Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), on the case at appeal.

Background

The sole issue for the Board of Patent Appeals and Interferences (the Board) for this case is whether claims 15, 16, 19-21, 24, and 25 have been properly rejected under 35 U.S.C. § 251 as an attempt to recapture a scope of invention that was surrendered during prosecution of Application Serial No. 08/321,857 (the '857 application). Appellants filed an Appeal Brief on January 29, 2001 and, after receiving an Examiner's Answer dated March

19, 2001, filed a Reply Brief on May 21, 2001. The Board ordered Appellants to file a Supplemental Appeal Brief to address the impact of the Pannu decision, in which the Court affirmed the judgment of the U.S. District Court for the Southern District of Florida granting summary judgment that U.S. Patent No. RE32,525 is invalid under 35 U.S.C. § 251 (the recapture rule), on this appeal. For the reasons detailed below, Appellants respectfully submit that the Federal Circuit's holding in Pannu does not support the rejection of claims 15, 16, 19-21, 24, and 25 under 35 U.S.C. § 251 and further submit that the Court's analysis of the recapture rule in Pannu is consistent with Appellants' position that the recapture rule is inapplicable in this case.

The Federal Circuit's Decision in Pannu

Pannu obtained U.S. Patent 4,435,855 (the '855 patent) on March 13, 1984 for an artificial intraocular lens (i.e., a plastic lens that may be implanted in an eye to replace a natural lens). The '855 patent issued from application Serial No. 261,953 (the '953 application), which was filed as a continuation-in-part application based on original application Serial No. 136,243. The '953 application disclosed a round lens called an "optic", which focuses light on the retina, and two or more elements called "haptics", which are attached to the optic and contact internal tissue of the eye to position and secure the optic. The haptics disclosed in the '953 application included "snag resistant" discs. Independent claim 1 of the '953 application was directed to a posterior chamber intraocular lens comprising, *inter alia*, a lens having a width and a thickness; and a retention loop including a flexible strand having a width and a thickness, such a strand being joined at one end to the lens and having an opposite free end. 59 USPQ2d at 1598.

In response to a rejection of claims, including independent claim 1, under 35 U.S.C. § 103 in light of various prior art references, Pannu cancelled claim 1 and added a new independent claim 16, directed to an intraocular lens comprising, *inter alia*, a lens body; and at least two flexible positioning and supporting elements integrally formed with the lens body and extending from the periphery of the lens body. Claim 16 specified that the elements define a continuous, substantially circular arc having a diameter greater than the diameter of the lens body, the arc being curved toward the lens circumference. 59 USPQ2d at 1598-99. In reply to the rejections under 35 U.S.C. § 103, Pannu relied on the shape of the claimed elements (haptics) to assert patentability of new claim 16, arguing that the shape of the haptics specified in the claim serves to “significantly enhance the easy insertibility of applicant’s lens and significantly reduce any possibility of snagging delicate eye tissue.” 59 USPQ2d at 1599. Pannu’s arguments were deemed persuasive by the Examiner, resulting in the allowance of claim 16, which was renumbered claim 1 in the ‘855 patent. 59 USPQ2d at 1599.

Pannu filed a Reissue Application in 1985, stating in the Reissue oath that the claims of the ‘855 patent were unduly narrow “by describing the shape of the outwardly extending elements as defining ‘a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.’” 59 USPQ2d at 1599. During prosecution of the Reissue Application, the Examiner allowed Pannu to delete the phrase “defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end” from claim 1, subject to the addition of claim language further defining a different feature,

the claimed "snag resistant means," resulting in the Reissue Patent No. 32,525 (the '525 Reissue). 59 USPQ2d at 1599.

During subsequent infringement litigation, the U.S. District Court for the Southern District of Florida granted the defendant's motion for summary judgment that the '525 Reissue improperly recaptured subject matter surrendered in obtaining the allowance of the '855 patent. Pannu v. Storz Instruments, Inc., 106 F. Supp. 2d 1304 (S.D. Fla. 2000).

In affirming the lower court, the Federal Circuit noted that the claim scope for the '953 application was limited in response to a prior art rejection to describe the shape of the haptics ("elements"), claim 16 of the '953 application describing the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body...." Pannu argued to the Examiner during prosecution of the '953 application that

no such particular shape is disclosed by the lenses of [applied references]. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand... [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape. 59 USPQ2d at 1600-01.

Thus, according to the Federal Circuit, the shape of the haptics was precisely the limitation relied on to secure allowance of the '855 patent. 59 USPQ 2d at 1601. Because the broadened aspect of the Reissue claim 1, removing the limitation of the shape of the haptics, removed precisely the limitation which was added to obtain allowance of the '855 patent, the Federal Circuit concluded that the Reissue Application was an improper attempt to recapture surrendered subject matter. 59 USPQ2d at 1601 (stating that "[o]n reissue [Pannu] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections").

Furthermore, although specifics of the claimed “snag resistant means” were added to claim 1 of the Reissue Application, these specifics were not a material narrowing of the claim because these specifics did not relate to the shape of the haptics (i.e., did not relate to the limitation that was added during prosecution to establish patentability).

Inapplicability of Pannu to the Case at Issue

The Federal Circuit’s holding in Pannu does not support the Examiner’s rejection under 35 U.S.C. § 251 because the broadened aspect of the rejected Reissue claims is not the precise limitation added to secure allowance of the ‘857 application. Moreover, the rejected Reissue claims are materially narrowed as compared to claims of the original patent.

1. The Disclosed Invention

As discussed in the “Summary of the Invention” section of the Appeal Brief filed January 29, 2001, the subject Reissue Application discloses a vertical turbine pump having a configuration that allows the operator to readily service the pump in the field. A disclosed embodiment, illustrated in Figs. 1-2, includes a bowl assembly (“pump bowl”) 10, a discharge conduit 24, and a discharge elbow 30. The pump bowl 10 has a casing that includes a bulbous diffuser section 12 located between narrow upstream and downstream sections 14, 16. A diffuser core 18 is provided within the casing in diffuser section 12 and a plurality of diffuser vanes 20 are spaced around the diffuser core 18. A suction bell 22, which is disposed below the surface of the liquid to be pumped during typical operation, is connected to the casing upstream section 14. The discharge conduit 24 is connected on

one end to the casing downstream section 16 and is connected to the discharge elbow 30 on the other end. A pump drive shaft 36 extends centrally and axially through the discharge elbow 30, the discharge conduit 24, and the diffuser core 18. An impeller 38, having spirally oriented vanes, is fastened to the lower end of drive shaft 36 within the casing upstream section 14 and beneath the diffuser core 18. During operation, the impeller 38 rotates to generate a flow of liquid upward through a passage within the casing diffuser section 12, through the discharge conduit 24 and the discharge elbow 30.

As shown in Fig. 3, the disclosed vertical turbine pump configuration includes a bearing cartridge 56 having a tubular housing 58. The tubular housing 58 is detachably secured within the diffuser core 18 to surround the drive shaft 36. In the embodiment illustrated in Fig. 3, axially spaced bearings 54 and 52, e.g., formed of metal or elastomeric sleeves, are fixed within the tubular housing 58 to surround and rotatably support the drive shaft 36.

With the disclosed vertical turbine pump configuration, the bearing cartridge 56 can be removed from the upstream direction of the pump by simply separating the suction bell 22 from the pump bowl casing, removing the impeller 38 from the end of the drive shaft, and disengaging the bearing cartridge 56 from the diffuser core 18. Thus, the entire pump does not have to be torn down to access the bowl bearing arrangement, which is particularly vulnerable to wear and degradation when handling solids-laden with liquid. In this way, the turbine pump according to Appellants' invention may be serviced in the field by a single person with minimum delay and tools.

2. Prosecution of the '857 Application

Originally-presented independent claim 1 of the '857 application recited a vertical turbine pump comprising, *inter alia*, a pump bowl assembly, a rotary impeller, and a diffuser core. Originally-presented dependent claim 4 of the '857 application recited a vertical turbine pump as defined in claim 1, further comprising: "a bearing cartridge separably fastened within said diffuser core, said bearing cartridge carrying axially spaced bearings which surround and rotatably support said drive shaft." In an Office Action dated April 25, 1995, Examiner Larsen rejected independent claim 1 but indicated allowability of dependent claim 4 (as well as other claims). In an Amendment dated July 25, 1995, claim 1 was amended to recite the "bearing cartridge" specified in allowable dependent claim 4, which was cancelled. The '857 application was subsequently allowed and issued as U.S. Patent 5,496,150 (the '150 patent) on March 5, 1996.

3. The Rejected Reissue Claims

Independent claims 15 and 20 of this Reissue Application were added to address an error in claim 1 of the '150 patent which unduly limited the scope of the '150 patent. More specifically, although claim 1 of the '150 patent recites a vertical turbine pump comprising, *inter alia*, a bearing cartridge separably fastened with a diffuser core and carrying axially spaced "bearings" which surround and rotatably support the pump drive shaft, the technical contributions of the disclosed embodiments, which facilitate field service of the turbine pump due to the relation of separable bearing cartridge to other pump

elements, does not require a multi-bearing bearing cartridge. In view of this error, the vertical turbine pump of Reissue claim 15 recites:

a bearing cartridge separably fastened to said diffuser core, said bearing cartridge surrounding and rotatably supporting said drive shaft, said bearing cartridge being removable from an upstream section of said casing by removing said impeller and disengaging said bearing cartridge from said diffuser core thereby permitting said bearing cartridge to be slid off said drive shaft in an axial direction. (Emphasis indicating language not present in claim 1 of the '150 patent).

Reissue claim 20 recites similar features.

4. Pannu Distinguished

Contrary to the facts of Pannu, the requirement for a plurality of bearings in the separable bearing cartridge was not the precise limitation that Appellants added/argued for claim 1 of the '857 application to establish patentability. Appellants submit that neither the disclosure nor the prosecution history of the '857 application suggests that Appellants considered a plurality of bearings in the separable bearing cartridge a significant feature for patentability. Neither the disclosure of the '857 application nor comments by Appellants during prosecution place emphasis on this feature. Instead, the disclosure of the '857 application emphasizes how the vertical turbine pump configuration and the removable bearing cartridge therein enables an operator to service the pump in the field by accessing the bearing cartridge, which is particularly vulnerable to wear, from the upstream section of the pump casing by removing the impeller and sliding the separable bearing cartridge off the drive shaft. See e.g., the Abstract; col. 5, lines 17-31; and col. 1, lines 40-51 of the

'150 patent. For at least this reason, the reasoning applied by the Federal Circuit in Pannu does not support the Examiner's rejection in this case.

Furthermore, contrary to the facts of Pannu in which the narrowed aspect of the Reissue claim did not relate to the limitation incorporated in the claims and argued during prosecution (i.e., the shape of the haptics), the features included in Reissue claims 15 and 20 do relate to the material aspects of the removable bearing cartridge, which was the feature added to independent claim 1 of the '857 application. Specifically, Reissue claim 15 specifies that the separable bearing cartridge is removable from an upstream section of the casing by removing the impeller and disengaging the bearing cartridge from the diffuser core, thereby permitting the bearing cartridge to be slid off the drive shaft in an axial direction. Independent Reissue claim 20 includes similar language. Thus, independent Reissue claims 15 and 20, although broader than patent claim 1 in the sense that a plurality of bearings are not required, are narrower in a material respect.

Conclusion

For the reasons set forth in the Appeal Brief dated January 29, 2001 and the Reply Brief filed May 21, 2001, and further in view of the above remarks regarding the Federal Circuit's decision in Pannu, Appellants respectfully request that the rejection of claims under the recapture rule be reversed.

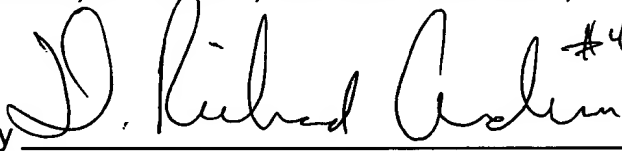
Should there be any outstanding matters that need to be resolved in the present Appeal, the Examiner or Honorable Board is respectfully requested to contact D. Richard Anderson (Reg. No. 40,439) at the telephone number of the undersigned below.

Application No. 09/034,313
Appeal No. 2001-2527

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #40,439

for Terrell C. Birch
Registration No. 19,382

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

TCB/DRA/jdm/kdb
2008-0108P